

JC860 U.S. PTO

04/10/01

## IN THE UNITED STATES PATENT AND TRADEMARK

## OFFICE

REQUEST FOR FILING  
(RULE 53(b)(1))FOR DESIGN OR UTILITY APPLICATIONS  
(DO NOT USE FOR CIPs)

## Rule 53(b)(1) PATENT APPLICATION:

- Continuation )  
 ) application under 37 CFR 1.53(b)(1)  
 Divisional )

of pending prior application of

Group Art Unit: 1632

Inventor(s): Steven L. Stice; Jose Cibelli; James M. Robl; Examiner: D. Crouch  
 Paul Goleuke; F. Abel Ponce De Leon; D.  
 Joseph Jerry

|                    |               |              |            |           |            |
|--------------------|---------------|--------------|------------|-----------|------------|
| Parent Appln. No.: | 08            | 935.052      | Atty. Dkt. | P 0280088 |            |
|                    | Series Code ♦ | Serial No. ♦ |            | New M#    | Client Ref |

Parent Filed: September 22, 1997

This Appln. Filed: April 10, 2001

Title: CLONING USING DONOR NUCLEI FROM DIFFERENTIATED FETAL AND ADULT CELLS

JC97\_U.S.PTO  
09/828876  
04/10/01

Hon. Commissioner of Patents  
 Washington, DC 20231

Date: April 9, 2001  
 (Parent Matter No. 276589 )

Sir:

To effect the above-requested filing today:

- 1.
- Attached**
- is a copy (
- which must be filed**
- ) of the prior application, including:

- Abstract  
 Specification and claims (61 pages) (**must be attached**)  
 Drawings (**must be attached if originally filed**): \_\_\_ sheet(s)/set:  1 set informal;  Formal of size  A4  11"

Always X one box, only:

- (1)  Copy of Signed declaration or oath as originally filed in prior application **attached**  
 (2)  NO declaration or fee is enclosed; therefore, this is a filing under Rule 53(f).

- 2.
- 
- This application is hereby filed by
- less than all of the inventors
- named in the prior application. Petition is hereby made requesting deletion as inventor(s) of the following who is/are
- not
- inventor(s) of the invention being claimed in this application (
- DELETE THE FOLLOWING INVENTOR(S)**
- ):

|    |       |    |       |
|----|-------|----|-------|
| 1. | _____ | 2. | _____ |
| 3. | _____ | 4. | _____ |
| 5. | _____ | 6. | _____ |
| 7. | _____ | 8. | _____ |

## 2.5 THE INVENTOR(S) FOR THIS NEW APPLICATION IS(ARE):

|    |       |    |       |
|----|-------|----|-------|
| 1. | _____ | 2. | _____ |
| 3. | _____ | 4. | _____ |
| 5. | _____ | 6. | _____ |
| 7. | _____ | 8. | _____ |

3. The entire disclosure of the prior application is considered as being part of the disclosure of the accompanying application and is hereby incorporated therein by reference thereto.

4.  Priority is claimed under 35 U.S.C. 119/365 based on filing in United States of  
(country)

| <u>Application No.</u> | <u>Filing Date</u>  | <u>Application No.</u> | <u>Filing Date</u>    |
|------------------------|---------------------|------------------------|-----------------------|
| (1) 08/781,752         | January 10,<br>1997 | (2) 08/935,052         | September 22,<br>1997 |
| (3) _____              | _____               | (4) _____              | _____                 |
| (5) _____              | _____               | (6) _____              | _____                 |

- a.  (No.) Certified copy/copies attached.  
 b.  Certified copy/copies previously filed on \_\_\_\_\_ in  
 U.S. Application No. \_\_\_\_\_ / \_\_\_\_\_, filed on \_\_\_\_\_  
series code ↑      ↑ serial no.  
 c.  Certified copy/copies filed during International stage of PCT/ \_\_\_\_\_ / \_\_\_\_\_  
 4(a). (a)  Domestic priority is claimed from \_\_\_\_\_ / \_\_\_\_\_, filed \_\_\_\_\_  
 PCT/  
 (b)  Benefit is claimed of Provisional Application No. 60/\_\_\_\_\_, filed \_\_\_\_\_

5.  Prior application is assigned to University of Massachusetts, a Public Institution of Higher Education of the Commonwealth of Massachusetts, as Represented by its Amherst Campus

by assignment recorded \_\_\_\_\_ Reel \_\_\_\_\_ Frame \_\_\_\_\_  
 (Date)

Attached is the following number of Assignments (including original and all later successive ones by different assignors): \_\_\_\_\_ and respective new Cover Sheets. (Do NOT file old cover sheets.)

(Assignments in parent must be refiled with new Cover Sheets in this continuing application if you want it/them recorded against the continuing application.)

Please return the recorded Assignment to the undersigned.

The power of attorney in the prior application is to Robin L. Teskin, Reg. No. 35.030

(Name and Reg. No.)  
 whose current address is as in item 8 below.

a.  Recognize as associate attorney Bonnie D. Weiss, Reg. No. 43,255

(Name, Reg. No. and Address)

8. **Address all future communications to Intellectual Property Group  
 of Pillsbury Winthrop LLP, Ninth Floor, East Tower 1100 New York Avenue, N.W.,  
 Washington, D.C. 20005-3918**

9. This application claims benefit of the following prior US application(s), the contents of which are incorporated into this application by this reference:

No. 08/ 781,752 filed January 10, 1997  
 No. 08/ 935,052 filed September 22, 1997  
 No. / filed \_\_\_\_\_

9(a).  See the attached Preliminary Amendment, which amends the first page of the specification to claim benefit of the above listed US application(s)

10. **Small Entity Status →**  is Not claimed  is claimed (pre-filing confirmation required)

(No.) Small Entity Statement(s) (not essential since 9/8/00) were/are:  
 filed in above prior application  
 attached.

11. Petition to extend the life of the above prior application to at least the date hereof  
 (one box)  is being concurrently filed in that prior application (Use Form PAT-111).  
 (must be)  was previously filed in that prior application (Check length of prior extension).  
 (X'd)  is not necessary for copendency (**Double check** before X'ing this box).

12.  **INFORMATION DISCLOSURE STATEMENT:** Attached is Form PTO-1449 listing all of the documents cited by Applicant and the PTO in the parent application(s) relied upon under 35 USC 120 and referenced in item 9 above. Per Rule 98(d) copies of those documents are not required now. Please consider those documents and advise that they have been considered in this new application as by returning a copy of the enclosed Form PTO-1449 with the Examiner's initials in the left column per MPEP 609.
13.  Attached is a Rule 103(a) Petition to Suspend Action.
14.  **PRELIMINARY AMENDMENT to be entered before fee calculation:** (Do not make amendments here except for correction of improper multiple dependencies or cancellation of whole claims or multiple dependencies for purpose of reducing the filing fee per MPEP §§ 506 and 607; do not cancel all claims).

**FILING FEE**

THE FOLLOWING FILING FEE IS BASED ON

->->->CLAIMS AS FILED AND CHANGED BY PRELIMINARY AMENDMENT IN ITEM 14<-<-<-

**NOTE:** If box 1A<sub>2</sub> is X'd, do not pay fees,  
but leave lines 15-22 and 27-32 blank.

**PTO: PLEASE NOTE CLAIM CANCELLATIONS IF BOX 14 ABOVE IS X'D.**

|  |                     |                   | Large/Small Entity | Fee Code |
|--|---------------------|-------------------|--------------------|----------|
| 15. Basic Filing Fee .....   | Design Application  | \$320/\$160       |                    | 106/26   |
| 16. Basic Filing Fee .....   | Utility Application | \$710/\$355       | +355               | 101/201  |
| 17. Total Effective Claims   | 77 minus 20 =       | 57                | x \$18/\$9         | +513     |
| 18. Independent Claims   | 3 minus 3 =         | 0                 | x \$80/\$40        | +0       |
| 19. If any proper multiple dependent claim (ignore improper) is present, |                     | \$270/\$135       | +0                 | 104/204  |
| 20.  |                     | <b>Subtotal =</b> | <b>\$868</b>       |          |
| 21. If "petition" box 13 above is X'd, add petition fee .....            | \$130               |                   | +0                 | 122      |
| 21A. If box 6 above is X'd, add Assignment recording fee .....           | \$ 40               |                   | +0                 | 581      |

TOTAL FILING FEE ATTACHED = **\$868**

(carry forward to Item 31)

23.  ATTACHED:
24.  Preliminary Amendment attached (to be entered after assigning Appln. No.)
25.  See NONPUBLICATION REQUEST under Rule 213(a) attached (Pat-258)

26.

**ADDITIONAL FEE CALCULATION FOR  
PRELIMINARY AMENDMENT  
PER BOXES 24/25**

| Claims<br>remaining<br>after<br>amendment   | Highest<br>number<br>previously<br>paid for | Present<br>Extra                | Additional<br>Fee         | <u>Large/Small Entity</u> | <u>File Code</u> |
|---|---|---------------------------------|---------------------------|---------------------------|------------------|
| 27. Total Effective Claims *0   | minus ** 20                                 | = 0                             | x \$18/\$9                | = \$ 0                    | (103/203)        |
| 28. Independent Claims *0   | minus *** 3                                 | = 0                             | x \$80/\$40               | = + 0                     | (102/202)        |
| 29. If amendment enters proper multiple dependent claim(s) into this application for the<br>first time, add (per application) ..... |   |                                 | .270/\$135                | + 0                       | (104/204)        |
| 30.   |   |                                 | ADDITIONAL FEE            | \$ 0                      |                  |
| 31.   |   | plus FEE from item 22 on page 3 |                           | + 868                     |                  |
| 32.   |   |                                 | <b>TOTAL FEE ATTACHED</b> | <b>\$ 868</b>             |                  |
| 33. "If the entry in this space is less than a entry in the next space, the "Present Extra" result is "0"                           |   |                                 |                           |                           |                  |
| 34. **If the "Highest number previously paid for" (see item 17 above) is less than 20, write "20" in this space                     |   |                                 |                           |                           |                  |
| 35. If the "Highest number previously paid for" (see item 18 above) is less than 3, write "3" in this space                         |   |                                 |                           | 00909                     |                  |
| Our Deposit Account No. 03-3975<br>Our Order No. 015837   | C#  | 0280088                         | M#                        |                           |                  |

**CHARGE STATEMENT:** Upon the filing of a Declaration pursuant to Rule 60(b) or 60(d), the Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficient fee only) now or hereafter relative to this application and the resulting Official document under Rule 20, or credit any overpayment, to our Account/Order Nos. shown above for which purpose a duplicate copy of this sheet is attached.

This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal form is filed.

**Pillsbury Winthrop LLP  
Intellectual Property Group**

|          |                        |          |                |
|----------|------------------------|----------|----------------|
| By Atty: | <u>Robin L. Teskin</u> | Reg. No. | <u>35,030</u>  |
| Sig:     | <u>Robin L. Teskin</u> | Fax:     | (202) 822-0944 |
|          |                        | Tel:     | (202) 861-3623 |

Atty./Sec RLT/csa

**NOTE No. 1:** File this Request in duplicate with 2 postcard receipts (PAT-103) & attachments  
**NOTE No. 2:** Is extension in parent necessary for copendency? **DOUBLE CHECK Item 11 above.**  
 If yes, printout Pat-111 and head it in parent.